

Appl. 10/601,828
Reply to Office Action of February 23, 2006
Amendment Dated May 23, 2006

REMARKS

The applicant responds to the pending Office Action as follows. Currently claims 1, 17-19 and 33-53 are pending in the application. Claims 1, 17-19, 32, 36, 40 and 43-50 stand rejected. Claims 33-35, 37-39, 41, 42 and 51-53 have been withdrawn from consideration. Claim 32 has been canceled without prejudice.

The applicant respectfully submits that the foregoing amendments to the specification and claims are fully supported by the application as originally filed and no new matter has been added. Therefore, entry of the foregoing amendments is respectfully requested.

Claim Rejections - 35 USC § 102/103

The Examiner has rejected claims 1, 18, 19, 40, 45-47 and 49 under 35 U.S.C. 102(b) as being anticipated by Sarka et al., (U.S. Patent No. 3,863,550), or in the alternative, under 35 U.S.C. 103(a) as being obvious over Sarka et al. in view of Beroz et al.

As previously indicated by the applicant, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference or embodied in a single prior art device or practice. *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). In each of the pending independent claims, namely claims 1, 40 and 47, the applicant has amended the claims to include "a layer of adhesive interposed between said back surface of said at least one metal base portion and said covering, said layer of adhesive structured for permanently

Appl. 10/601,828
Reply to Office Action of February 23, 2006
Amendment Dated May 23, 2006

attaching said back surface of said at least one metal base portion to said covering." The applicant respectfully submits that Sarka et al. fails to teach such a layer of adhesive and therefore does not anticipate the claimed invention. In addition, the applicant reiterates its prior arguments that Sarka et al. does not disclose a covering or housing as recited in the claims and in particular as currently amended in that that the covering or housing of the claimed invention is configured to be permanently attached through the adhesive to the back of the metal plate.

Accordingly, the applicant respectfully submits that Sarka et al. fails to anticipate the claims as presently amended.

With respect to the combination of Sarka et al. and Beroz et al., the applicant respectfully submits that the Examiner has not satisfied the burden of establishing a *prima facie* case of obviousness. As recited in 706.02(j) of the MPEP, "First, there must be some suggestion or motivation, either in the references themselves or to one of ordinary skill in the art, to modify the references or to combine reference teachings." Moreover, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

As stated by the Examiner, "Beroz discloses one example of the use of such an adhesive to temporarily hold components in place during assembly." (emphasis added) The claims now recite, "a layer of adhesive interposed between said back surface of said at least one metal base portion and said covering, said layer of adhesive structured for permanently

Appl. 10/601,828

Reply to Office Action of February 23, 2006

Amendment Dated May 23, 2006

attaching said back surface of said at least one metal base portion to said covering." The applicant respectfully submits that neither Sarka et al. nor Beroz et al., alone or in combination, teach or suggest such permanency. Indeed, as previously argued by the applicant the cited prior art teaches exactly the opposite in that Sarka et al. teaches the use of mold release for the specific purpose of ease of removal of the die from the mold and thus fails to provide any motivation as required under Section 103(a). The only teaching of the features of the claimed invention is found in applicant's disclosure. Specifically, the application of the adhesive layer in applicant's invention is very different from any teaching or suggestion in the cited prior art, namely for "the use of such adhesive in the assembly arts and know that it is often applied to assist in the assembling of components . . . " as stated by the Examiner. Accordingly, the applicant respectfully submits that the claims are neither taught nor suggested by the prior art and are in condition for allowance.

Appl. 10/601,828
Reply to Office Action of February 23, 2006
Amendment Dated May 23, 2006

CONCLUSION

The Examiner is welcome to call the attorney of record, Frank W. Compagni, at (801) 478-0071 if further discussion of this matter is warranted. Any fees due hereunder may be charged to Deposit Account No. 50-0881.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Frank W. Compagni', is written over a horizontal line.

Frank W. Compagni
Attorney for Applicant
Registration No. 40,567
MORRISS O'BRYANT COMPAGNI, P.C.
136 South Main Street, Suite 700
Salt Lake City, Utah 84101
(801) 478-0071 telephone
(801) 478-0076 facsimile